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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,679	08/31/2001	Douglas J. Pearson	10017718-1	3775

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CHUONG, TRUC T

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 11/29/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,679

Applicant(s)

PEARSON, DOUGLAS J.

Examiner

Truc T Chuong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to Amendment A, filed 09/07/04.
2. Claims 1-36 are pending in this application. Claims 1, 11, 18, 27, and 34 are independent claims. In Amendment A, claim 5 is amended, and claims 34-36 are new claims. This action is made final.
3. From the Remarks on page 8 of the Amendment A, Examiner appreciates that Applicant has caught an error and pointed out the incorrectly cited reference (Shibuya-U.S. Patent No. 5,579,416 instead of Itoh-U.S. Patent No. 5,255,353) using in the previous Office Action; therefore, Examiner will correct the problem by changing the inventor name Itoh to Shibuya corresponding to the U.S. Patent No. 5,579,416 when rejecting claims 1-36.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 103

5. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibuya (U.S. Patent No. 5,579,416) in view of Washington et al. (U.S. Patent No. 6,515,682 B1).

As to claims 1 and 11, Shibuya teaches a user interface and a software application comprising shadow information representing a shadow direction for an object to be rendered that when actuated actuates the rendering of a shadow having the shadow direction from the rendered object (shadow information 33, e.g., col. 1 lines 48-62, and figs. 3A & 6); however, Shibuya does not clearly teach an actuatable icon on a GUI. Washington clearly shows of using icons

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from a GUI in OLE controls of Visual Basic to create and edit icons, control objects, forms, etc. (e.g., col. 3 lines 1-25, col. 9 line 48-col. 10 line 51, figs. 21-22). It would have been obvious at the time of the invention, that a person with ordinary skill in the art would want to be able to use the GUI of Washington in the shadow information controls of Shibuya to improve visualization for a user when editing an object.

As to claims 2 and 12, Shibuya teaches the user interface as defined in Claim 1, further comprising an actuatable icon representing a shadow length for the rendered shadow that when actuated actuates the rendered shadow having the shadow length (magnification, e.g., col. 6 lines 12-55, col. 7 lines 31-76, and figs. 9G-F).

As to claim 3, Shibuya in view of Washington teaches the user interface as defined in Claim 1, wherein the actuatable icon is a menu item on a menu (Washington, Properties with icons of figs. 21-22).

As to claims 4 and 13, Shibuya in view of Washington teaches the user interface as defined in Claim 3, wherein the menu item is a numerical expression (e.g., col. 8 lines 45-63, and figs. 3A, 9G-F).

As to claims 5 and 14, Shibuya teaches the user interface as defined in Claim 4, wherein the numerical expression includes one or more of degrees and radians (e.g., col. 7 lines 31-58, angle and direction of figs. 3A, C, and 6).

As to claim 6, Shibuya teaches the user interface as defined in Claim 3, wherein the menu item is a compass point direction (parameters of angle, e.g., col. 2 lines 10, and figs. 3A & 6).

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As to claims 7 and 16, Shibuya teaches the user interface as defined in Claim 3, wherein the rendered object having the shadow direction is rendered upon the menu (it can be rejected under similar rationale of claim 1 above).

As to claim 8, Shibuya in view of Washington teaches the user interface as defined in Claim 7, further comprising a print actuation icon that when actuated actuates the printing of shadowed objects having the shadow direction (Washington, print icon on the GUI of figs. 21-22).

As to claim 9, Shibuya in view of Washington teaches the user interface as defined in Claim 8, wherein a word processor software application actuates the display of the menu (Washington, Properties of figs. 21-22).

As to claim 10, Shibuya teaches the user interface as defined in Claim 7, wherein the printing operation is selected from the group consisting of printing (printer, e.g., col. 4 lines 1-31), magnetic tape recording, photo imaging substrate recording, and magneto optical storage device writing.

As to claim 17, Shibuya teaches the user interface as defined in Claim 16, wherein:

the point is on the rendering of the predetermined object (shadow information 33, e.g., col. 1 lines 48-62, and figs. 3A & 6); and

the pointing device manipulates the point by a point, click, and drag operation (clicking by using pointing device, e.g., col. 7 lines 30-65).

As to claims 18-25, they are method claims of system claims 1, 2, 4-6, 8, 3, and 10. Note the rejections of claims 1, 2, 4-6, 8, 3, and 10 above respectively.

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As to claim 26, it is a computer program product claim of method claim 18. Note the rejection of claim 18 above.

As to claim 27, Shibuya in view of Washington teaches a shadow rendering system comprising:

a display device (a display, e.g., col. 3 lines 1-22 and figs. 1A & 2A);

a host computer in electrical communication with the display device and performing a demand print application program including the steps of:

serving a user interface for display as a menu item on the menu, the icon representing a selection of a shadow direction for the predetermined object (Washington, Properties with icons of figs. 21-22, and Shibuya, figs. 3A-C, 6, 9B & C); and

upon the actuation of said menu item:

executing an application program on the host computer to calculate a rendering of a shadow having the appearance of being cast from the rendered predetermined object in the selected shadow direction (e.g., col. 5 lines 4-41, and figs. 3A-C, 6, 9B & C); and

displaying the calculated shadow rendering as being cast from the rendered predetermined object in the selected shadow direction (e.g., col. 5 lines 4-41, col. 6 lines 43-62, and figs. 3A-C, 6, 9B & C).

As to claim 28, Shibuya in view of Washington teaches the system as defined in claim 27, wherein:

the shadow rendered by the application program executing on the host computer has a default length (magnification, e.g., col. 6 lines 12-55, col. 7 lines 31-76, and figs. 9G-F); and

the demand print application program further includes the steps of:

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displaying a second actuable icon on the menu as a second menu item representing a selectable shadow length for the rendered shadow (Washington, e.g., figs. 21-22); and

upon the actuation of said second menu item (Washington, e.g., figs. 21-22), said application program executing on the host computer further performing the step of rendering the shadow having the selected shadow length (shadow information 33, e.g., col. 1 lines 48-62, and figs. 3A & 6).

As to claims 29-33, they are similar in scope to claims 4-6, 8, and 10 above; therefore, rejected under similar rationale.

As to claims 34-36, they are computer program product claims of system claims 1, 8, and 7. Note the rejections of claims 1, 8, and 7 above respectively.

Response to Arguments

6. Applicant's arguments filed 09/07/04 have been fully considered but they are not persuasive.

Applicant has argued following statements, and Examiner disagrees for following reasons:

a. Shibuya fails to teach of controlling a shadow direction.

Examiner disagrees with the Applicant because Shibuya clearly teaches that an object can be tilted, painted, shadowed and the like as feature of vector fonts (col. 3 lines 23-28); figs. 3A-C & 6 clearly show the GUI for

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setting/adjusting/magnifying the shadow, directions and size of the object, and the angle of tilting on X or Y coordinate will change the shadow of that object.

- b. The shadow direction of Shibuya is fixed and cannot be controlled.

The direction can be controlled by changing/setting/adjusting/magnifying the object, and the angle of tilting on X or Y coordinate will change the shadow of the object (3A-C & 6).

Based on the strongly supported evidence as mentioned above, Shibuya clearly provides all limitations, which have addressed in the Claims and the Arguments by the Applicant except that the icon can be interacted/actuated like a GUI icon. There is a strong suggestion to combine with a reasonable motivation between Shibuya and Washington to improve visualization for a user when editing an object.

All other arguments can be addressed under similar as a and b above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T Chuong whose telephone number is 571-272-4134. The examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Truc T. Chuong

11/22/04


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